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EXAMINER

GERGISO, TECHANE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/566,945	<b>Applicant(s)</b> BAUBAN ET AL.	
	<b>Examiner</b> TECHANE J. GERGISO	<b>Art Unit</b> 2437	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/02/2007 and 02/03/2006</u> .                               | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This is a non-Final Office Action in response to the applicant's communication filed on November 02, 2007.
2. Claims 1-11 have been examined and are pending.

### ***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

4. The information disclosure statements (IDS) submitted on November 02, 2007 and February 03, 2006 are in compliance with the provisions of 37 CFR 1.97 and accordingly, the information disclosure statement have been considered by the examiner.

### ***Oath/Declaration***

5. The Oath filed on June 28, 2006 complies with all the requirements set forth in MPEP 602 and therefore accepted.

### ***Claim Objections***

6. Claims 2-8 are objected to because of the following informalities:

Art Unit: 2437

In claims 2-8: line 1, “An Authentication server” should be “The Authentication server”.

Appropriate correction is required.

In claim 1: line 5, “the server” should be either “the authentication server” or “the service server”. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1, 10 and 11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 recites “An authentication server for automatically selecting one of a plurality of authentications”. Use of the word “**server**” does **not** inherently mean that the claim is directed to a **machine**. Only if at least one of the claimed elements of the server is a **physical part of a device** can the server as claimed constitute part of a device or a combination of devices to be a **machine** within the meaning of 101. Claim 1 is directed to comprise [**a selector arrangement for selecting an authentication identifier in a memory and an authentication arrangement for authenticating said user**], and these claimed elements are not a processes occurring as a result of executing the software program, not a machine programmed to operate in accordance with the software program, not a manufacturer structurally and functionally interconnected with the program in a manner which enables the software program to act as a computer component and

Art Unit: 2437

realize its functionality. They are also clearly not directed to a composition of matter. Therefore, claim 1, **to those of ordinary skill in the art, may all be reasonably implemented as a software routines** and therefore claim 1 is rejected as **an authentication server of software or program per se**, failing to fall within a statutory category of invention and rejected as non-statutory under 35 USC 101.

Even though applicant has invoked the rebuttable presumption that 35 USC 112, 6<sup>th</sup> paragraph applies in the claim interpretation of the “**a selector arrangement for selecting an authentication identifier in a memory and an authentication arrangement for authenticating said user**” corresponding structure in the disclosure is not automatically and inherently limited to hardware-inclusive embodiments. It is entirely possible for the corresponding disclosed “means” to cover an embodiment of software alone.

[See the applicant’s disclosure for indicating the invention implemented as a program: 0075 and Figure 1: Authentication Server SA]: “**the invention applies equally to a computer program adapted to implement the invention, in particular a computer program on or in an information medium**. This program may use any programming language and be in the form of source code, object code, or an intermediate code between source code and intermediate code, such as in a partially compiled form, or in any other form suitable for implementing a method of the invention”.

Claim 10 recites “A **computer program** on an information **medium**”. Claim 10 is directed to a program itself, not a process occurring as a result of executing the program, a machine programmed to operate in accordance with the program nor a manufacturer structurally

Art Unit: 2437

interconnected with the program in a manner which enables the program to act as a computer component and realize its functionality. In addition, the "information medium" would suggest to one of ordinary skill *signals or other forms of propagation and transmission media, typewritten or handwritten text on paper, or other items* failing to be an appropriate manufacturer under 35 USC 101 in the **context of computer-related inventions** [See the applicant's disclosure for **medium : 0075**]. Therefore, claim 10 fails to fall within a statutory category of invention and rejected as non-statutory.

Claim 11 recites "A data processor arrangement for performing the method of claim 9" and is directed to a data processor arrangement. Claim 10 is not directed to a Process within the meaning of 101, since it is not a series of steps or acts being performed. It is not directed to a Machine since is not a part of a device or a combination of devices. It is not a Manufacturer within the meaning of 101, since it is not an article produce from raw or prepared materials. It is also not a Composition of Matter within the meaning of 101, since it not a combination of two or more substances nor does it have any mass to be matter. Therefore, claim 11 fails to fall within a statutory category of invention and rejected as non-statutory.

### ***Double Patenting***

9. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v.*

Art Unit: 2437

*Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-11 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-11 of copending Application No. 11/346,211. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sawa et al. (hereinafter referred to as, Sawa, US Pub. No.: 2003/0097593) in view of Ritola et al. (hereinafter referred to as Ritola, US Pub. No.: 2005/0289341).

As per claim 1:

Art Unit: 2437

Sawa discloses an authentication server for automatically selecting one of a plurality of authentications identified respectively by authentication identifiers in order to authenticate a user of a terminal in order to authorize the user to access a service dispensed by a service server of a provider identified by a provider identifier via a communication network the server comprising:

a selector arrangement for selecting an authentication identifier in a memory as a function of the type of at least one of said terminal and said communication network (0044; 0048; 0049; 0053; 0056: an authentication method suitable for the user terminal is selected, by using the data of a request for service from a user terminal and various types of authentication methods are supported, and accordingly various types of terminals can be supported. The terminal information object preparation process, the carrier or communication employer and type of user terminal that issues an HTTP request are specified).

an authentication arrangement for authenticating said user by using an authentication process associated with said authentication identifier (0058; 0059: Using the determined authentication method, various types of data, for example, a user's name, passwords, etc., required for the authentication process are obtained, and an authentication database is accessed, thereby checking the validity of a user terminal).

Sawa does not explicitly teach the authentication identifier as a function of the provider identifier. Ritola, in analogous art, however teaches the authentication identifier as a function of the provider identifier (0048; 0051; 0052; provides service if authentication by identity provider identifier corresponding to each service provider stored in memory of the terminal is successful). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the



Art Unit: 2437

invention was made to modify the system disclosed by Sawa to include the authentication identifier as a function of the provider identifier. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so to provide a reliable and more secure automated authentication method and system from a service provider's authentications request without a user intervention as suggested by Ritola in (0005; 0006).

As per claim 2:

Sawa discloses an authentication server, wherein said selector arrangement is arranged to select said authentication identifier as a function of an authentication security level (0058: set selected authentication method with a high security level as the authentication method with high priority). Sawa does not explicitly teach authentication identifier a function to said provider identifier. Ritola, in analogous art, however teaches authentication identifier in corresponding relationship to said provider identifier (0048; 0051; 0052; provides service if authentication by identity provider identifier corresponding to each service provider stored in memory of the terminal is successful). See motivation given in claim 1.

As per claim 3:

Sawa discloses an authentication server, wherein said selector arrangement is arranged to select said authentication identifier as a function of authentication rules associated with and applied to at least an authentication security level corresponding to said terminal type and said communication network type (0069-0070; matrix for determining authentication method in the authentication method decision process). Sawa does not explicitly teach authentication identifier

Art Unit: 2437

a function to said provider identifier. Ritola, in analogous art, however teaches authentication identifier in corresponding relationship to said provider identifier (0048; 0051; 0052; provides service if authentication by identity provider identifier corresponding to each service provider stored in memory of the terminal is successful). See a motivation given in claim 1.

As per claim 4:

Sawa discloses an authentication server, wherein said service server comprises a transmitter for transmitting at least one of said terminal type and said communication network type to said selector arrangement in response to a connection set up between said user terminal and said service server (0097; content of HTTP header analysis for carrier type and terminal type ). Sawa does not explicitly teach a transmitter for transmitting said provider identifier. Ritola, in analogous art, however teaches a transmitter for transmitting said provider identifier (Figure 4: identity provider identifier authentication request response communication). See a motivation given in claim 1.

As per claim 5:

Sawa does not explicitly teach an authentication server, wherein said selector arrangement is arranged to transmit to said terminal a list of services identified by service identifiers in response to a connection set up between said user terminal and said selector arrangement, and said user terminal is arranged to transmit to said selector arrangement a service identifier of a service selected by said user in the transmitted list in order for said selector or arrangement to select said authentication identifier as a function also of said selected service

Art Unit: 2437

identifier. Ritola, in analogous art, however teaches an authentication server, wherein said selector arrangement is arranged to transmit to said terminal a list of services identified by service identifiers in response to a connection set up between said user terminal and said selector arrangement, and said user terminal is arranged to transmit to said selector arrangement a service identifier of a service selected by said user in the transmitted list in order for said selector or arrangement to select said authentication identifier as a function also of said selected service identifier (Figure 5: 51 select different single sign authentication module corresponding to each service provider by selecting identity provider 57; Figure 4: identity provider identifier authentication request and response communication between terminal and service provider).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system disclosed by Sawa to include an authentication server, wherein said selector arrangement is arranged to transmit to said terminal a list of services identified by service identifiers in response to a connection set up between said user terminal and said selector arrangement, and said user terminal is arranged to transmit to said selector arrangement a service identifier of a service selected by said user in the transmitted list in order for said selector or arrangement to select said authentication identifier as a function also of said selected service identifier. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so to provide a reliable and more secure automated authentication method and system from a service provider's authentications request without a user intervention as suggested by Ritola in (0005; 0006).

As per claim 6:

Art Unit: 2437

Ritola discloses an authentication server, wherein said selector arrangement is arranged to transmit said terminal a list of provider identifiers in response to a connection set up between said user terminal and said selector arrangement and said terminal is arranged to transmit to said selector arrangement a provider identifier selected by said user in the transmitted list in order for said selector arrangement to select said authentication identifier as a function of said selected provider identifier (0051; 0052: IDP displays a list of identity providers that are acceptable by service provider and terminal; a user selects a particular provider identifier and sends an authentication request).

As per claim 7:

Sawa discloses an authentication server, wherein, if said user has been authenticated, the authenticator arrangement is arranged to transmit to said service server said terminal type, said communication network type, said transmitted service identifier, and a security level of the authentication designated by said selected authentication identifier (0095; 0096; 101; terminal information object cache).

As per claim 8:

Sawa discloses an authentication server, further comprising two separate servers respectively including said selector arrangement and said authenticator arrangement (0051; 0052; mobile agent server; web server, and mobile agent; mobile agent for selecting an authentication method).

Art Unit: 2437

As per claim 9:

Sawa discloses a method of automatically selecting one of a plurality of authentications identified respectively by authentication identifiers in order to authenticate a user of a terminal to authorize said user to access a service dispensed by a service server of a provider identified by a provider identifier via a communication network, the method comprising:

selecting an authentication identifier in a memory as a function of the type of at least one of said terminal and said communication network (0044; 0048; 0049; 0053; 0056: an authentication method suitable for the user terminal is selected, by using the data of a request for service from a user terminal and various types of authentication methods are supported, and accordingly various types of terminals can be supported. The terminal information object preparation process, the carrier or communication employer and type of user terminal that issues an HTTP request are specified), and

authenticating said user by an authentication process associated with said authentication identifier (0058; 0059: Using the determined authentication method, various types of data, for example, a user's name, passwords, etc., required for the authentication process are obtained, and an authentication database is accessed, thereby checking the validity of a user terminal).

Sawa does not explicitly teach the authentication identifier as a function of the provider identifier. Ritola, in analogous art, however teaches the authentication identifier as a function of the provider identifier (0048; 0051; 0052; provides service if authentication by identity provider identifier corresponding to each service provider stored in memory of the terminal is successful). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the

Art Unit: 2437

invention was made to modify the system disclosed by Sawa to include the authentication identifier as a function of the provider identifier. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so to provide a reliable and more secure automated authentication method and system from a service provider's authentications request without a user intervention as suggested by Ritola in (0005; 0006).

As per claim 10:

Sawa discloses a computer program on an information medium: adapted to be loaded into and executed by an authentication server for automatically selecting one of a plurality of authentications respectively identified by authentication identifiers in order to authenticate a user of a terminal in order to authorize said user to access a service dispensed by a service server of a provider identified by a provider identifier via a communication network, said program including program instructions for:

selecting an authentication identifier in a memory as a function of the type of at least one of said terminal and type of said communication network (0044; 0048; 0049; 0053; 0056: an authentication method suitable for the user terminal is selected, by using the data of a request for service from a user terminal and various types of authentication methods are supported, and accordingly various types of terminals can be supported. The terminal information object preparation process, the carrier or communication employer and type of user terminal that issues an HTTP request are specified), and

authenticating said user by an authentication process associated with said authentication identifier (0058; 0059: Using the determined authentication method, various types of data, for

Art Unit: 2437

example, a user's name, passwords, etc., required for the authentication process are obtained, and an authentication database is accessed, thereby checking the validity of a user terminal).

Sawa does not explicitly teach the authentication identifier as a function of the provider identifier. Ritola, in analogous art, however teaches the authentication identifier as a function of the provider identifier (0048; 0051; 0052; provides service if authentication by identity provider identifier corresponding to each service provider stored in memory of the terminal is successful). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system disclosed by Sawa to include the authentication identifier as a function of the provider identifier. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so to provide a reliable and more secure automated authentication method and system from a service provider's authentications request without a user intervention as suggested by Ritola in (0005; 0006).

As per claim 11:

Claim 11 is a data processor arrangement for performing the method of claim 9. Therefore, claim 11 is rejected with a similar rational and reason given above to reject claim 9 as being unpatentable over Sawa in view of Ritola.

### ***Conclusion***

12. The prior arts made of record and not relied upon are considered pertinent to applicant's disclosure. See the notice of reference cited in form PTO-892 for additional prior arts.

Art Unit: 2437

***Contact Information***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Techane J. Gergiso whose telephone number is (571) 272-3784 and fax number is (571) 273-3784. The examiner can normally be reached on between 9:00am - 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Techane J. Gergiso/

Examiner, Art Unit 2437